

REMARKS

The Office Action has been fully and carefully considered. At the outset, Applicants gratefully acknowledge the allowance of claims 1-19. Only claims 20-23 now stand rejected. Because Applicants believe that claims 20-23 are patentable over the prior art and that the rejection of claims 20-23 cannot be sustained, Applicants respectfully request that the Examiner reconsider the position taken in the Final Office Action in light of the remarks which are to follow.

Claims 20-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman (U.S. Patent No. 3,918,601) in view of Schmitz, Jr., et al. (U.S. Patent No. 4,039,093) (hereafter, Schmitz).

The rejection begins with a conclusion rather than findings of fact coupled with an analysis. It states that one having ordinary skill in the art would have found it obvious "to provide a boom lock on the Zimmerman cylinder 24 in view of the teaching in Schmitz to provide direct protection to the hydraulic cylinder enhancing safety." It further states that element "68 in Schmitz is synonymous with applicants' collar." Plainly, these conclusions derive from Applicants' disclosure, not from the disclosures of Zimmerman and Schmitz. No *prima facie* case of obviousness has been established.

The burden lies with the PTO to establish a *prima facie* case. See MPEP § 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of

success. Finally, the prior art reference must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and must not be based on Applicants' disclosure. See MPEP § 2143.

First, there is no motivation to somehow combine any teachings or suggestions found in Schmitz with Zimmerman. Plainly, Zimmerman and Schmitz disclose safety mechanisms of a generally similar kind. That is to say, both disclosures express interest in holding a boom aloft for safety during equipment servicing and provide structure toward that end. But a careful review of the two patents reveals that they offer mutually exclusive solutions to the general problem of boom or linkage support. There is nothing to suggest the combining of one with the other in the manner proposed in the Office Action.

In Zimmerman, the support 40 (Fig. 2) fully supports the boom from beneath with no hint that there might be some reason to provide further support for the boom via the hydraulic cylinders. As a matter of fact, a primary reason for the support in Zimmerman is to permit removal of the hydraulic cylinders. See, for example, col. 1, lines 36-38, col. 1, lines 51-54, and col. 2, lines 62-64 of Zimmerman. It would not have been obvious to redundantly provide Zimmerman with a lock for the hydraulic cylinder, like that in Fig. 4 of Schmitz, when Zimmerman is already provided with a boom support at 40. This is particularly true when one skilled in the art considers the fact that a primary reason for the boom support in Zimmerman is to allow removal of the hydraulic cylinders associated with the boom.

On the other hand, Schmitz suggests boom support by mechanism 58 (Fig. 4, or 42 in Fig. 3) by actual engagement with the cylinder itself. What one skilled in the art would glean from Schmitz and Zimmerman is that there are alternative ways to support a lift boom. There is simply no suggestion in either reference that it would be desirable or beneficial (i.e., no motivation) to somehow provide a collar on a cylinder of Zimmerman, even if one were to accept the dubious proposition that clevis 68 (attached to 58 in Fig. 4) of Schmitz is "synonymous with applicants' collar," a proposition with which Applicants cannot agree.

Second, there is no reasonable expectation of success as to the combination suggested. To reiterate, the two devices, that of Schmitz and that of Zimmerman, are mutually exclusive. One skilled in the art would not perceive that the two could be combined at all. Evidence of this is apparent in the embodiment of Fig. 1 of Schmitz which is generally similar in construction to the restraint of Zimmerman in the sense that it engages a portion of the boom itself, while the other embodiments of Schmitz (Figs. 3 and 4) engage one of the hydraulic cylinders. One skilled in the art would elect one or the other (a device engaging a cylinder as in Schmitz, Figs. 3 and 4, or a device engaging the boom as in Zimmerman and as in Schmitz, Fig. 1), and would not recognize or expect any success at combining them.

Third, even if the structure or the reasonable teachings of the two references, Zimmerman and Schmitz, were to somehow be combined, not all the claimed elements would result from the combination. This is because the clevis 68 (or 46) in Schmitz does not fairly constitute a collar that is attached to the hydraulic cylinder. Rather, to

the extent that the Schmitz clevis may reasonably be construed as a "collar," it is attached to the lock bar 58 (or 42) and merely abuts the cylinder when the lock bar freely falls onto the cylinder upon being released from its inoperative position. In this regard, see, for example, column 4 of Schmitz at lines 18-27. Thus, to the extent one could actually combine the respective teachings of Zimmerman and Schmitz (and Applicants maintain that they could not do so with any reasonable expectation of success, and that there is no motivation to do so that flows from the prior art), the result would be a clevis that freely falls to abut the cylinder, not one that is attached to the cylinder.

Accordingly, none of the three required elements of a *prima facie* case of obviousness has been met. The Office has not met its burden. The rejection of claims 20-23 for obviousness should be withdrawn and claims 20-23, it is urged, should be found allowable.

Conclusion

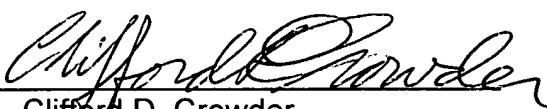
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the remaining rejected claims 20-23. If, upon consideration of this response and reconsideration of the rejection of claims 20-23 the Examiner is of the view that there remain matters which need to be addressed in order to expedite allowance of this application, then the Examiner is invited to telephone the undersigned at 571-203-2757 so that prosecution may be brought to a mutually beneficial conclusion.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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